

Question Q217

National Group: CZECH NATIONAL GROUP

Title: The patentability criterion of inventive step / non-obviousness

Contributors: JUDr. Jan HÁK, Ph.D.

Reporter within Working Committee: [please insert name]

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. In our jurisdiction an invention shall be considered as inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.
2. The standard of an inventive step is defined in the Patent Act No. 527/1990 Coll., and therefore it has not been changed in the last 20 years.
3. Our patent-granting authority publishes examination guidelines on inventive step. These guidelines were published on January 01, 2006 and there are applicable in the examination procedure.
4. The standard for inventive step does not differ during examination and invalidity procedures.

Construction of claims and interpretation of prior art

5. The claims are constructed literally.
6. The extent of the protection conferred by a patent shall be determined by the terms of the patent claims. For the interpretation of the patent claims, the description and drawings shall be used. Therefore it is possible for the extent of the patent to read embodiments from the body of the specification.
7. The prior art would be understood by a applicant.
8. The answers to any of the questions above do not differ during the examination versus during the litigation.

Combination or modification of prior art

9. In our jurisdiction it is not proper to find lack of inventive step or obviousness over a single prior art reference.
10. To combine two or more prior art references it is required to object the lack of inventive step.
11. Two or more prior art references are combined in the case of inventive step objection.
12. In our jurisdiction it is permitted to combine more than two references to show lack of inventive step.
13. The answers to any of the questions above do not differ during examination versus during invalidity procedure.

Technical Problem

14. The technical problem to be solved does not play in determining inventive step.
15. The technical problem must be disclosed or identified in the specification in a brief extent.

Advantageous effects

16. In determining inventive step or non-obviousness advantageous effects have important role.
17. The advantageous effects must be disclosed in the specification.
18. Is it impossible to have later-submitted data considered by the Examiner.
19. The advantageous effects must be submitted in the specification in the common form and must be specified in examples of inventive embodiment.
20. The answers to any of the questions above do not differ during examination versus during invalidity procedure.

Teaching away

21. Our jurisdiction does not recognize teaching away as an important factor in favour of inventive step.
22. Among the other factors supporting inventive step teaching away have no important role.
23. There is no difference in how teaching away is applied during examination versus in litigation.

Secondary considerations

24. There are no secondary considerations recognized in our jurisdiction.
25. There is no a close connection between the *claimed* invention and the secondary considerations required.
26. The answers to any of the questions above do not differ during examination versus during litigation.

Other considerations

27. There are no other issues, tests, or factors that are taken into consideration in determining inventive step in our jurisdiction.

Test

- 28. There is no specific statement of the test for inventive step/non-obviousness in our jurisdiction.
- 29. No answer.

Patent granting authorities versus courts

- 30. There are no areas not already described above where the approach to inventive step taken during examination diverges from that taken by courts.
- 31. There is no divergence in approach to inventive step between the courts and the patent granting authority in our jurisdiction.

Regional and national patent granting authorities

- 32. We have only one patent granting authority covering our jurisdiction.
- 33. No answer.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

- 34. It seems to us that a harmonization of inventive step is not desirable.
- 35. It is not possible to find a standard for inventive step that would be universally acceptable.
- 36. According to our Patent Act an invention shall be considered as involving an inventive step if, having regard to the state of the art, is not obvious to a person skilled in the art. Such a definition for inventive step would be considered to be broadly acceptable.
- 37. Such a definition could be used by examiners and by courts in determining inventive step.